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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WEEKS, GLORIA R	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ALINE ABERGEL

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Appeal 2008-3779  
Application 10/698,415  
Technology Center 3700

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Decided: February 25, 2009<sup>1</sup>

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Before WILLIAM F. PATE, III, JOHN C. KERINS, and  
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

Aline Abergel (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-16, 18 and 25-33. Claims 17 and 19-24 are canceled and claims 25-28 are withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b) (2002). An oral hearing was held on February 12, 2009, with Christopher Bullard, Esq., appearing on behalf of Appellant.

## SUMMARY OF DECISION

We AFFIRM-IN-PART.

## THE INVENTION

Appellant's claimed invention is to a device for packaging a product, preferably a cosmetic product, having a support or base and a lid articulated to the support or base. The support has a cavity containing the product. In one claimed embodiment, the support and lid are articulated to each other by an arrangement comprising a sticker forming a mirror, the sticker being adhesively bonded to onto a face of the lid and onto one of the surfaces of the support. (Appeal Br., Claims Appendix, claim 1). In another claimed embodiment, the support and the lid are articulated to each other by an arrangement comprising an adhesive sheet fixed onto one face of the lid and onto one of the faces of the support. (Appeal Br., Claims Appendix, claim 16). This latter claimed embodiment also provides that the cavity containing the product opens on both a first and second side of the support, and that the adhesive sheet that articulates the lid to the support also closes off the second opening of the cavity, and further that the portion of the adhesive sheet covering the second opening directly faces a second side of the product contained in the cavity. (*Id.*).

Claims 1 and 16, reproduced below, are representative of the claimed subject matter:

1. A device for packaging a product comprising:

a support having a flat overall shape and having two faces, said support further including at least one cavity that passes at least partially through said support and which opens on a first face of said two faces through a first opening, and wherein said cavity contains a product;

a lid having a flat overall shape, and wherein said lid is articulated to the support; and

wherein the support and the lid are articulated to each other by an arrangement comprising a sticker forming a mirror adhesively bonded onto a face of the lid and onto one of the faces of the support.

16. A device for packaging a product comprising:

a support having two faces, said support further including at least one cavity that passes through said support and which opens on a first face of said two faces through a first opening, wherein the cavity opens on a second side of said two faces through a second opening, and wherein said cavity contains a product having a first side adjacent said first opening and a second side adjacent said second opening;

a lid, wherein said lid is articulated to the support; and

wherein the support and the lid are articulated to each other by an arrangement comprising an adhesive sheet fixed onto one face of the lid and onto one of the faces of the support, wherein the

adhesive sheet closes off said second opening of the cavity with a portion of said adhesive sheet which covers said second opening directly facing said second side of said product contained in said cavity.

#### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Matney	US 4,469,226	Sep. 4, 1984
Coburn, Jr.	US 4,491,389	Jan. 1, 1985
Parrotta	US 4,890,872	Jan. 2, 1990
Destanque	US 6,412,640 B1	Jul. 2, 2002
Kelly	US 2004/0003825 A1	Jan. 8, 2004
Verespej	US 7,025,220 B2	Apr. 11, 2006 <sup>2</sup>
Guiard <sup>3</sup>	WO 9715910	May 1, 1997

The Examiner has rejected:

- (1) Claims 1-3, 8, 9, and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Coburn, Jr. (hereafter “Coburn”) and Destanque;
- (2) Claim 10 under 35 U.S.C. § 103(a) over Kelly in view of Coburn and Destanque, and further in view of Guiard, Verespej and Matney;
- (3) Claims 11 and 12 under 35 U.S.C. § 103(a) over Kelly in view of Coburn and Destanque, and further in view of Parrotta;

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<sup>2</sup> Previously published as US 2003/0159403 A1, on August 28, 2003.

<sup>3</sup> Specific cites to the Guiard reference herein are to the English language translation dated May 2008, of record.

- (4) Claims 7, 16, 18 and 33 under 35 U.S.C. § 103(a) over Kelly in view of Guiard and Parrotta;
- (5) Claims 4-6 and 29 under 35 U.S.C. § 103(a) over Kelly in view of Guiard and Parrotta, and further in view of Coburn; and
- (6) Claims 30-32 under 35 U.S.C. § 103(a) over Kelly in view of Guiard, Parrotta, and Coburn, and further in view of Verespej and Matney.

### ISSUES

- (A) The Examiner concluded that the combined teachings of Kelly, Coburn, and Destanque render unpatentable a packaging device having a lid and a support, the support having a cavity therein, and a mirror sticker attached to a face of the lid and support to articulate the lid and support relative to each other.

Appellant urges that none of the cited references discloses a mirror sticker that provides a reflective surface as well as being bonded onto a face of each of the lid and support, and serves to articulate the lid and support relative to each other.

The issue joined is: has Appellant demonstrated that the Examiner erred in interpreting the teachings of the references, and in combining the teachings in the manner done in reaching the conclusion of unpatentability.

- (B) The Examiner concluded that the combined teachings of Kelly, Guiard and Parrotta renders unpatentable a packaging device having a lid and a support, the support having a cavity extending therethrough and open at both faces thereof, wherein

an adhesive sheet is fixed onto a face of the lid and support to articulate them relative to each other, and wherein the adhesive sheet closes off one opening of the cavity and directly faces a second side of a product contained in the cavity.

Appellant contends that the combination of the teachings of these references do not render obvious a packaging device in which an adhesive sheet covering an opening in a cavity directly faces a second side of a product contained in the cavity.

The issue joined is: has Appellant demonstrated that the Examiner erred in interpreting the teachings of the references, and in combining the teachings in the manner done in reaching the conclusion of unpatentability.

#### FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF 1. The Kelly patent discloses a device for packaging a product that includes a support having a flat overall shape, two faces, and at least one cavity containing a product, the cavity being open on one of the faces, and a lid articulated to the support. (Kelly, Fig. 1; p. 2, ¶[0018]).

FF 2. The Guiard reference discloses a first technique for fixing a cosmetic product into a cavity in a package by force fitting the product into the cavity. (Guiard, p. 8, l. 21).

FF 3. Kelly discloses that the product can be force fit into cavity 14a, and be adhesively bonded to hinge base section 24a, as an alternative to

bonding the product to base 14. (Kelly, p. 3, ¶[0027]). In that embodiment, the cavity 14a would have no bottom surface, and the product would directly contact the portion of the adhesive strip underlying the base.

FF 4. Guiard discloses two alternate embodiments as options for the cavity in the support that will hold the cosmetic product, a cavity that extends completely through the support to be open at both faces, and a cavity that is a blind hole not open to the bottom face of the support. (Guiard, p. 6, ll. 8-12).

FF 5. Hinge 24 in Kelly is disclosed as being adhesively bonded to base 14 and lid 16, as well as, in one embodiment, to pan 12a. (Kelly, p. 2, ¶[0020]; p. 3, ¶[0027]).

FF 6. Kelly discloses that the cosmetic materials may be inserted directly into cavities, without requiring the use of pans. (Kelly, p. 5, ¶[0036]).

#### PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, \_\_\_, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR Int’l.*, 550 U.S. at \_\_\_, 127 S. Ct. at



1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

"[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR Int'l*, 550 U.S. at \_\_\_, 127 S.Ct. at 1740, citing *United States v. Adams*, 383 U.S. 39, 50-52.

During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading limitations disclosed in the specification into the claim. *See, In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

## ANALYSIS

### *Claims 1-3, 8, 9, and 13-15*

Appellant argues these claims as a group, and we will treat claim 1 as the representative claim of the group.

The Examiner relies on the Kelly patent as teaching a device for packaging a product that includes a support having a flat overall shape, two faces, and at least one cavity containing a product, the cavity being open on one of the faces, and a lid articulated to the support. (Answer 3; FF 1). The Examiner also asserts that Kelly discloses an arrangement comprising a sticker 24 adhesively bonded to one of the faces of the lid and one of the faces of the support. (Answer 3). The Examiner notes that Kelly does not disclose that the sticker 24 forms a mirror. (*Id.*)

The Examiner cites to Coburn as teaching the forming of a mirrored sticker, and cites to Destanque as teaching the desirability of providing multiple mirrored surfaces on a packaging device, including both internal and external surfaces. (Answer 3-4). The conclusion reached by the Examiner is that it would have been obvious, in view of these teachings, to modify the Kelly structure to form the sticker 24 as a mirrored sticker, and, once so modified, the mirrored sticker would be adhesively bonded onto a face of the lid and onto one of the faces of the support and would serve to articulate the lid and support to each other. (Answer 11-12).

Appellant counters that Coburn does not disclose its mirror being in the form of a sticker (Appeal Br. 6), and further that none of the Kelly, Coburn and Destanque patents discloses or suggests providing a mirrored element that is capable of articulating a lid and a support relative to one another. (Appeal Br. 8). Rather, Appellant contends, each of the three patents discloses single mirrors on single faces. (Reply Br. 7).

We are persuaded that it was error to conclude that the combined teachings of the Kelly, Coburn and Destanque patents would suggest to a person of ordinary skill in the art to use a mirror element in a manner whereby it would articulate a lid to a support. As pointed out by Appellant, each of the three patents discloses single mirrors on single faces, with the possibility that more than one mirrored surface could be provided on a single package. None suggests providing a mirrored element capable of articulating a lid and a support relative to one another, however. (Appeal Br. 7-8).

We will not sustain the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Kelly in view of Coburn and Destanque. Similarly, we

will not sustain the same rejection directed to claims 2, 3, 8, 9, and 13-15, which depend from claim 1.

*Claim 10*

Claim 10, which depends from claim 1, is rejected under 35 U.S.C. § 103(a) over Kelly in view of Coburn and Destanque, and further in view of Guiard, Verespej and Matney. Appellant presents no separate argument for the patentability of this claim.

The Examiner has pointed to no teachings in the Guiard, Verespej and Matney patents that overcome the deficiencies noted above with respect to the Kelly, Coburn and Destanque disclosures, and we see none either.

The rejection of claim 10 will not be sustained.

*Claims 11 and 12*

Claims 11 and 12, which depend from claim 1, are rejected under 35 U.S.C. § 103(a) over Kelly in view of Coburn and Destanque, and further in view of Parrotta. Appellant presents no separate argument for the patentability of these claims.

The Examiner has pointed to no teachings in the Parrotta patent that overcome the deficiencies noted above with respect to the Kelly, Coburn and Destanque disclosures, and we see none either.

The rejection of claims 11 and 12 will not be sustained.

*Claims 7, 16, 18 and 33*

Appellant argues these claims as a group, and we will treat claim 16 as the representative claim of the group. Claims 7, 18 and 33 depend from claim 16, and will stand or fall with that claim.

The Examiner again relies on the Kelly patent as teaching a device for packaging a product that includes a support having a flat overall shape, two

faces, and at least one cavity containing a product, the cavity being open on one of the faces, and a lid articulated to the support. (Answer 6; FF 1). The Examiner also asserts that Kelly discloses an arrangement comprising an adhesive layer or sticker 24 adhesively bonded to one of the faces of the lid and one of the faces of the support. (Answer 6). The Examiner notes that Kelly does not disclose that the at least one cavity opens on both a first side and a second side of the two faces. (*Id.*).

The Examiner cites to the Guiard reference as disclosing a packaging device in the form of a support having a cavity containing a product, the cavity passing through the support and opening on both faces of the support, with an adhesive sheet closing off a second opening of the cavity, and directly facing a second side of the product. (Answer 6, 13-14). The Examiner further cites to the Parrotta patent as disclosing that it was known in the packaging art to mount a cosmetic composition in a cavity backed directly by an adhesive sheet. (Answer 7, 14). The Examiner concludes that it would have been obvious to modify the Kelly packaging device to have a cavity extending completely through the support, in view of Guiard, the resulting structure thus having the Kelly adhesive sheet closing off a second opening, and directly facing a second side of the product disposed in the cavity. (Answer 6, 13). Parrotta is relied on as providing a teaching of supporting a cosmetic product directly on an adhesive film, in the event that the cosmetic product and surrounding pan disclosed in either Kelly or Guiard is not interpreted as reading on the claimed “product”. (Answer 7, 14).

Appellant attempts to discredit the Examiner’s conclusion by attacking the references individually, and by arguing that there is no

motivation to combine the teachings of the references to arrive at the claimed packaging device. (Appeal Br. 10-11). Appellant further argues that, even with the proposed modification of Kelly, the combination does not result in the claimed device. (Appeal Br. 11).

Appellant asserts that the Guiard packaging device does not include a base and a lid, and that the adhesive fixation sheet 22 in Guiard that is fixed to a surface of support 11 and retains the product (tray 18, compacted powder 20) in the recess 16 is not also fixed to a face of a lid, because the Guiard device fails to disclose a lid. (Appeal Br. 10). It is plainly apparent that Guiard does not disclose a lid, just as it is plainly apparent that the rejection is not founded on the teachings of Guiard alone. As noted above, the Guiard reference is relied upon for its teaching of a cavity that extends through the entire support to be open at both faces, in the assertion that it would have been obvious to provide such a cavity in the support 14 disclosed in the Kelly device, which device does include a lid.

Appellant continues with a contention that a person of ordinary skill in the art would not be motivated to modify the Kelly packaging device to incorporate a cavity extending through to both opposing faces of the support. First, we note that in the *KSR* case, the Supreme Court held that a rigid application of a “teaching, suggestion, motivation” test was incompatible with its precedent concerning obviousness. *KSR Int’l.*, 398 U.S. at \_\_\_, 127 S.Ct. at 1734.

Second, Appellant attempts to establish a lack of motivation to combine based upon an alleged distinction between the Kelly and Guiard devices which does not exist. Appellant contends that, in Kelly, the product is force fit into cavity 14a and may be adhesively bonded to the base 14 or

the hinge base section 24a, whereas, in Guiard, “without the means [adhesive fixation sheet] 22, the tray 18 could conceivably fall through the second hole in [the] Guiard [device].” (Appeal Br. 10). The Guiard reference discloses that a first technique for fixing the product in the cavity is by force fitting the product into the cavity. (FF 2). So, in both devices, the product is force fit into the cavity.

Further, the Kelly patent itself appears to suggest an embodiment in which, like Guiard, the cavity extends completely through the base or support. This is evidenced in the passage referred to by Appellant above. In the case where the product in Kelly is force fit into cavity 14a, and is adhesively bonded to hinge base section 24a (as opposed to the base 14), the cavity 14a would have no bottom surface, and the product would directly contact the portion of the adhesive strip underlying the base. (FF 3). Beyond this apparent teaching in Kelly itself of the alternative use of a cavity open at both surfaces, Guiard even more clearly identifies these two alternatives as options for the cavity in the support that will hold the cosmetic product. (FF 4). The use of one cavity configuration or the other is thus shown by at least Guiard as being nothing more than a simple substitution of one type of known cavity for another, with the obtention of predictable results. *KSR Int’l.*, 398 U.S. at \_\_\_\_, 127 S.Ct. at 1740.

Appellant’s argument that the combined teachings of the cited references do not result in the claimed device also falls short of the mark. Appellant contends that, in the resulting combination:

the cosmetic material 12 would still be separated from the hinge 24 (which is not an adhesive sheet) by the pan 12a. At best, the hinge 24 would cover a second opening *directly facing a bottom surface*

*of the pan 12a, not the cosmetic material 12. Thus the hinge 24 would not be an adhesive sheet which covers a second opening directly facing a second side of the product contained in the cavity, as presently claimed.*

Appeal Br. 11 (emphasis in original).

The principal contention here involves the interpretation of the claim term, “product”. In the Kelly and Guiard references, the cosmetic material is disclosed as preferably being held in a pan (Kelly) or in an aluminum tray (Guiard). The emphasized portions of Appellant’s argument quoted above indicate that Appellant contends that the pan or tray is not properly considered a part of the claimed “product” (presumably only a cosmetic material would be the product), and thus the adhesive sheet<sup>4</sup> in the modified Kelly device is not directly facing the product.

We are constrained, in cases before us, to give claim elements their broadest reasonable interpretation, consistent with the specification, and the scope of a claim cannot be narrowed by reading limitations disclosed in the specification into the claim. *In re Morris*, 127 F.3d at 1054; *In re Zletz*, 893 F.2d at 321; *In re Prater*, 415 F.2d at 1404-05. Appellant, in urging us to interpret the claimed “product” as being limited to a “cosmetic material” is seeking to have us restrict claim 16 to an embodiment of the invention which is not so limited by the claim language.

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<sup>4</sup> Appellant states, without any evidence or reasoning in support, that hinge 24 of Kelly is not an adhesive sheet. Hinge 24 is, however, adhesively bonded to base 14 and lid 16, as well as, in one embodiment, to pan 12a. (FF 5). We are not persuaded by Appellant’s unsupported assertion that Kelly fails to disclose an adhesive sheet as claimed.

Claim 16 calls for a “device for packaging a product”, and nowhere else in the claim is the term “product” further limited or restricted. (Appeal Br., Claims Appendix). The device in Kelly packages a “product” *preferably* comprising a cosmetic material contained within a pan<sup>5</sup>, and, similarly, the device in Guiard packages a “product” comprising a cosmetic material contained in a tray. We decline to, and indeed cannot, narrow the scope of claim 16 by interpreting it to be limited to the disclosed embodiment in which the “product” consists solely of a cosmetic material.

Appellant has failed to establish that the Examiner erred in rejecting claim 16 under 35 U.S.C. § 103(a) as unpatentable over Kelly in view of Guiard and Parrotta. We will sustain the rejection of claim 16, as well as that of claims 7, 18 and 33, which depend from claim 16 and are argued as standing or falling therewith.

*Claims 4-6 and 29*

Claims 4-6 and 29, which depend from claim 16, are rejected under 35 U.S.C. § 103(a) over Kelly in view of Guiard and Parrotta, and further in view of Coburn. Appellant presents no separate arguments for the patentability of these claims, relying on the same arguments as presented for claim 16.

Those arguments directed to claim 16 do not address the claim elements set forth in claims 4-6 and 29, and are thus unpersuasive as to the existence of any error in the rejection of these claims, as well.

The rejection of claims 4-6 and 29 will be sustained.

*Claims 30-32*

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<sup>5</sup> Kelly discloses, alternatively, that the cosmetic materials may be inserted directly into cavities, without requiring the use of pans. (FF 6).



Claims 30-32, which depend from claim 16, are rejected under 35 U.S.C. § 103(a) over Kelly in view of Guiard and Parrotta, and further in view of Coburn, Verespej and Matney. Appellant presents no separate argument for the patentability of these claims.

Those arguments directed to claim 16 do not address the claim elements set forth in claim 30, and are thus unpersuasive as to the existence of any error in the rejection of this claim, as well.

Claim 31 includes a recitation of “said make-up product”, whereas claims 16, 29 and 30 from which claim 31 depends, recite (via language in claim 16), only a “product”. Claim 32 depends from claim 31, and thus is interpreted as also including the claim element, “said make-up product”.

While the term “make-up product” is arguably narrower in scope than the term “product” discussed above with respect to claim 16<sup>6</sup>, Appellant has presented no evidence or reasoning that persuades us that it would be unreasonable to interpret “make-up product” as being sufficiently broad to encompass a cosmetic material contained within a pan or tray. Accordingly, as with claim 16 above, we are not persuaded that error exists in the rejection of claims 31 and 32

The rejection of claims 30-32 will be sustained.

## CONCLUSION

Appellant has established that reversible error exists in the rejection of claims 1-3 and 8-15 under 35 U.S.C. § 103(a). Appellant has not established

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<sup>6</sup> The term “said make-up product” also appears to lack proper antecedent basis in the claims.

Appeal 2008-3779  
Application 10/698,415

that reversible error exists in the rejection of claims 4-7, 16, 18, and 29-33 under 35 U.S.C. § 103(a)

ORDER

The decision of the Examiner to reject claims 1-3 and 8-15 is REVERSED. The decision of the Examiner to reject claims 4-7, 16, 18, and 29-33 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED-IN-PART

vsh

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